

REMARKS

Reconsideration of this application is respectfully requested in view of the following remarks.

Claims 1-31 and 63 are pending in this application. The Examiner rejected claims 1-2, 8, 10-13, 18-19, 22, 24, 26-29, and 63 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,093,718 to Hoarty et al. ("Hoarty") in view of U.S. Patent No. 5,506,902 to Kubota ("Kubota"); claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Hoarty in view of Kubota and further in view of U.S. Patent No. 5,210,611 to Yee et al. ("Yee"); claims 4-5 and 20-21 under 35 U.S.C. § 103(a) as being unpatentable over Hoarty in view of Kubota and further in view of U.S. Patent No. 5,632,022 to Warren et al. ("Warren"); claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Hoarty in view of Kubota and further in view of U.S. Patent No. 4,367,848 to Poignet et al. ("Poignet"); claims 7 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Hoarty; and claims 9, 14-17, 25, and 30-31 under 35 U.S.C. § 103(a) as being unpatentable over Hoarty in view of U.S. Patent No. 5,475,399 to Borsuk ("Borsuk").

The Applicants hereby traverse the rejection, as follows. The Applicants submit that Kubota is not an appropriate reference for a rejection of claims 1-31 and 63 under 35 U.S.C. §§ 102(e) or 103(a). This application is a continuation in part of U.S. Application Serial Number 08/336,247 (filed November 7, 1994), which is a continuation-in-part of U.S. Application Serial Number 07/991,074 (filed December 9, 1992) and U.S. Application Serial Number 08/160,194 (filed December 9, 1993). The Applicant submits that each of the elements of claims 1-24 is supported in U.S.

Application Serial No. 08/160,194 (filed on December 2, 1993) to which the present application claims priority under 35 U.S.C. § 120. As the U.S. filing date of Kubota is April 15, 1994, the Applicant respectfully submits that Kubota is not a proper reference that may be used to reject claims 1-31 and 63 under 35 U.S.C. §§ 102(e) or 103(a). For at least these reasons, the Applicant requests withdrawal of these rejections.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page 4. This is an insufficient showing of motivation.

CONCLUSION

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited. Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300.

Respectfully submitted,

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